

### **REMARKS/ARGUMENTS**

Reconsideration and allowance of the present application based on the following remarks are respectfully requested.

At the outset, it is respectfully submitted that Applicant's amendment did not necessitate the new grounds of rejection. The original claims already stated that the solvent extraction composition included one or more esters with a hydroxy group. All that was added by the amendment to claim 1 was the further definition of the ester (from unexamined claim 4). Accordingly, any of the rejections now made and any of the references now cited could have been made and cited in the first Action.

Accordingly, although Applicant is filing a Notice of Appeal due to the expiration of the statutory period for response, it is respectfully requested that the finality of the rejection be withdrawn.

With regard to the Examiner's rejection of Claims 1-3, 5-14, 15-25 under 35 U.S.C. 102(b), as being clearly anticipated by WO 98/28454, or EP 202833 or Virnig '605 (newly cited), Applicant submits that the rejection is in error.

It appears that the rejection, at least in part, is based on the disclosure in each of these references of a diester, 2,2,4-trimethylpentane-1,3-diol diisobutyrate. However, there is no hydroxy group in this compound, both of the hydroxy groups of the diol having been converted to ester groups. Therefore, since only the diol diester is disclosed in WO 98/28454 and EP 202833, neither of these references anticipate the embodiments of Applicant's invention as presently claimed.

The newly applied Virnig '605 does mention 2,2,4-trimethyl-1,3-pentanediol mono- or di-butyrate among various potential solubility modifiers (see col. 5, lines 2-13). However, even in light of this disclosure Virnig '605 fails to anticipate any of the embodiments of Applicant's invention as presently claimed because there is no explicit disclosure of the combination of any of the solubility modifiers with one or more orthohydroxyarylaldoximes or orthohydroxyarylketoximes, as set forth in claim 1, or in combination with a water immiscible solvent, as set forth in claim 2. There is no disclosure of the combination of any of the solubility modifiers with any of the compounds of Formula (1), as set forth in claim 3, or with any of the specific compounds named in claims 5, 6, 21, or 22. There is no disclosure of, and therefore, no anticipation of a process, such as set forth in claims 10-14 or 16-20 or

23-25, wherein a dissolved metal is contacted with a solvent extraction composition comprising a water immiscible organic solvent and a water-immiscible solvent extractant which further comprises one or more orthohydroxyarylaloximes or orthohydroxyarylketoximes and one or more esters substituted with a hydroxy group as in the compounds of formula (2).

Therefore, the rejection of claims 1-3, 5-14 and 16-25 as anticipated by WO 98/28454 or EP 202833 or Virnig '605, should be withdrawn.

Similarly, the disclosure of Kordosky '522 mentions 2,2,4-trimethyl-1,3-propane diol diisobutyrate but no other esters. Accordingly, this reference does not disclose an ester substituted with an hydroxy group. Therefore, Kordosky '522 fails to anticipate any of claims 1-3, 5-14, 16-22, 24 or 25. Accordingly, the rejection of these claims as anticipated by Kordosky '522 is improper and should be withdrawn.

There are also corresponding rejections of claims 1-3, 5-14 and 16-25 under 35 USC 103(a) as unpatentable over any one of WO 98/28454 or EP 202833 or Virnig '605; and of claims 1-3, 5-14, 16-22, 24 or 25 as unpatentable over Kordosky '522.

Applicant respectfully disagrees and traverses this rejection for at least the following reasons.

One skilled in the art, having the disclosures of the cited references would not be motivated to replace the highly branched diester, disclosed in each of the cited references as the standard ester type modifier, with a hydroxy group containing highly branched ester nor would the practitioner have a reasonable expectation of achieving any different or improved result by making this substitution.

The data provided in the specification of the subject application which demonstrates that a solvent extractant composition which includes an hydroxy group containing ester of Formula (2) provides unexpectedly higher copper transfer than the known commercial ester modifier but without an hydroxy group (*see*, Example 1 and Comparative Example A and Table 1 versus Table 2 on pages 13 and 14 of the specification). This data must be considered as strong evidence rebutting any case of *prima facie* obviousness.

More particularly, following the general methodology described on page 11-13, the levels of modifiers required to achieve target minimum strip values at three different loadings and at three different pH loading conditions were determined. The results according to the

invention are shown in Table 1 on page 13. The results for the comparative example are shown in Table 2 on page 14. In each case, the modifier according to the present invention, having a free hydroxyl group, could be used in a lower amount to achieve the minimum strip value under each set of load/strip conditions. Furthermore, the results demonstrate that in addition to the lower amount of modifier required to achieve the minimum strip value, the Net Copper Transfer was also higher for the examples according to the invention.

Therefore, since these results could not have been expected based on the prior art, it is respectfully submitted that Applicant is entitled to obtain a patent for the discovery disclosed and claimed herein.

In conclusion, the compositions and processes of the present invention are novel and inventive. Applicant believes the application is in order for allowance.

Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned attorney for Applicant at the telephone number indicated below in order to expeditiously resolve any remaining issues.

Respectfully submitted,

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